REMARKS

The abstract of the disclosure has been objected to for exceeding 150 words. Applicant has amended the abstract and respectfully requests withdrawal of the objection on this ground.

Claims 1, 6-8, 14-15, 17, 28, and 33-34 have been amended. Claims 1-34 are therefore currently pending in the application.

Claims 6-8, 14, 17-20, and 33-34 stand rejected under 35 U.S.C. § 112 for lacking antecedent basis for the limitations "the proposal," "the combined charges," "the principal professionals," and "the response reviewing engine." In response to the rejections, Claims 6-8, 14, 17, and 33-34 have been amended to provide sufficient antecedent basis.

Claims 1-24 and 28-34 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner contends that Claims 1-14 and 28-34 recite an abstract idea and that the elements of Claim 1 do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The Examiner also contends that Claims 15-24, when given their broadest reasonable interpretation appear to be devoid of any technology device.

Applicant respectfully disagrees with the bases of the rejection. The pertinent case law requires only that the claimed invention produce a "useful, concrete, and tangible" result. With due respect, the Office's concern that the claims are devoid of any technological device is misplaced. In *AT&T Corp. V. Excel Communications, Inc.*, 172 F.3d 1352, the Federal Circuit concluded that claims that require "generating a message record," which could, albeit impractically, be done by a person, "fall comfortably within the broad scope of patentable subject matter under 101." There are few if any meaningful differences between the *Excel Communications* case, and the current situation. Nonetheless, to further prosecution, the Applicant has amended Claims 1, 15, and 28 to address this rejection. Accordingly, Applicants respectfully request reconsideration of the rejection of Claims 1-24 and 28-34 and 4-5 under 35 U.S.C. § 101.

Claims 1-2, 6-17, 22-29, and 33-34 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over United States Published Application No. 2004/0065758 assigned to Henley (hereinafter referred to as "Henley").

The subject matter of Henley concerns methods and systems for purchasing medical services. As described in paragraph 104, Henley teaches a method for purchasing "medical services at a price determined by buyers" where "a registered buyer 74 logs onto a system 16, selects a medical service that the buyer wishes to acquire, and proffers a purchase price for the medical service." The method proposed by Henley further includes posting the buyer's offer on a "services wanted" bidding database. The "services wanted" bidding database is accessible to registered providers of medical services. The registered providers of medical services can view the buyer's offer, and, if a registered provider of medical services wishes to provide medical services at the price offered, the registered provider submits an offer to sell the specified services. The buyer can then either accept or reject the offer submitted by the provider of medical services. The offer submitted by the provider of the medical services can include conditions, such as "the location and date that the services will be rendered."

It should be noted that the majority of the subject matter of Henley concerns methods and systems for purchasing medical services where a prospective buyer bids on offers presented by a provider or services. As described in paragraph 120 of Henley, providers post services and specific requirements/conditions (i.e., prices, times, location, etc.) to a "posting database and prospective buyers can make a bid on the services.

In contrast to both of the above methods, amended Claim 1 of the present application specifies a method of selling healthcare services to a patient, and includes, among other things, preparing a case statement based on the case statement information; transmitting the case statement over the network to at least one contracting healthcare service provider; and transmitting a response from the at least one contracting healthcare service provider over the network, where the response includes a price, a clinical track record, and service information.

Among other things, Henley does not disclose a "case statement." As described on page 9, lines 23-29 of the present application, a case statement may contain "the reasons for the requested medical care and a description of the chief complaint, the history of the present illness,

the past medical history of the patient, a review of systems (which, as is known in the art, refers to a head-to-toe review of bodily functions), the current medications of the patient, allergies, and other pertinent findings (such as physical signs, laboratory values, imaging results, and results of special tests)." The case statement provides a way for the healthcare service provider to determine a specific response and/or a proposal including a price to be offered to the patient. The "registration form" cited by the Office is not a "case statement." Therefore, Henley does not teach or suggest "preparing a case statement based on the case statement information." Rather, Henley suggests posting a purchase offer for a selected medical service or a procedure offer for a medical service to a database.

Furthermore, Henley does not teach or suggest "transmitting the case statement over [a] network to at least one contracting healthcare service provider," as required by amended Claim 1. As described above, Henley posts a purchase offer made by a prospective buyer to a database, where a provider of services can view the offer. The provider of services accesses the database and views the purchase offers.

Furtherstill, Henley does not teach or suggest "transmitting a response from the at least one contracting healthcare service provider, the response including a price, a clinical track record, and service information," as also required by amended Claim 1. The method disclosed in Henley in paragraph 104, provides a method where the price is set by the prospective buyer and is either accepted or rejected by the provider of the service. The provider of services does not return a price to the prospective buyer since the price is set by the prospective buyer.

Therefore, for the reasons set out above, independent Claim 1 and dependent Claims 2-14, which depend on Claim 1, are allowable.

Amended Claim 15 specifies a system of selling healthcare services. The system includes, among other things, "a case statement engine configured to generate case statements based on case statement information" and "a case statement distribution engine to deliver case statements to healthcare service providers." As described above for amended Claim 1, Henley does not teach or suggest "a case statement engine configured to generate case statements based on case statement information." Rather, Henley teaches posting purchase offers or service offers

to a database where providers of service or prospective buyers can respectively view posted information.

Further, Henley does not teach or suggest "a case statement distribution engine to deliver case statements to healthcare service providers." As also described above, Henley posts offers to a database where a provider of services can view the offer.

Therefore, for the reasons set out above, independent Claim 15 and dependent Claims 16-27, which depend on Claim 15, are allowable.

Amended Claim 28 of the present application specifies a method of selling healthcare services to a patient. The method includes, among other things, "preparing a case statement based on the case statement information," "establishing case statement profile criteria for each of the plurality of contracting healthcare service providers," "making the case statement available to each contracting healthcare service provider whose profile criteria matches the case statement," and "receiving a response to the case statement from at least one contracting healthcare service provider, the response including a price, a clinical track record, and non-clinical information."

Henley, however, as described above for Claims 1 and 15 does not teach or suggest "preparing a case statement based on the case statement information." Also, Henley does not teach or suggest "establishing case statement profile criteria for each of the plurality of contracting healthcare service providers." The portion of Henley referenced by the Examiner (paragraph 104, lines 1-10) specifies registration forms for providers of services and buyers of services. The registration forms, as disclosed in Henley, provide a mechanism for a provider of services to list their "qualifications" for providing services and provide a mechanism for the buyer to list their "credit worthiness." The registration forms described in the lines cited by the Examiner do not teach or suggest "establishing case statement profile criteria." As described on pages 15-16, lines 29-9 of the present application, the case statement profile criteria allows a healthcare service provider to specify case statements that should be transmitted to the healthcare service provider and does not strictly specify "qualifications" as taught by Henley. The criteria can filter case statements within a procedural/medical area, associated with patients within a certain distance of the healthcare provider, and/or associated with patients carrying a type of insurance.

Further, Henley does not teach or suggest "making the case statement available to each contracting healthcare service provider whose profile criteria matches the case statement." As described above, Henley does not establish profile criteria nor case statements, and, furthermore, Henley does teach or suggest comparing profile criteria to a case statement to determine a case statement to make available to a healthcare service provider.

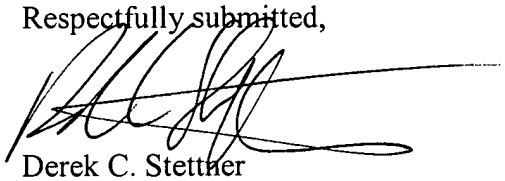
Also, Henley also does not teach or suggest "receiving a response to the case statement from at least one contracting healthcare service provider, the response including a price, a clinical track record, and non-clinical information. As described above for Claim 1, The provider of services does not return a price to the prospective buyer since the price is set by the prospective buyer or is initially posted by the provider of services and bid upon by the prospective buyer.

Therefore, for the reasons set out above, independent Claim 28 and dependent Claims 29-34, which depend on Claim 28, are allowable.

Claims 4-5, 19-21, and 31-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henley in view of United States Patent No. 5,519,607 issued to Tawil (hereinafter "Tawil"). In light of the deficiencies of Henley noted above, Applicant submits that the proposed combination does not meet all of the claim limitations. Accordingly, Claims 4-5, which depend from independent Claim 1, are therefore allowable for the reasons set forth above with respect to Claim 1. Claims 19-21 depend on independent Claim 15 and are allowable for the reasons set forth above with respect to Claim 15. Claims 31-32 depend from independent Claim 28 are allowable for reasons set forth above with respect to Claim 28. Claims 4-5, 19-21, and 31-32 also include additional patentable subject matter not specifically discussed herein.

In light of the above, Applicant believes that the application is in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case. Applicant also requests that the Examiner telephone the attorneys of record in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Respectfully submitted,



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